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10/756,090

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EXAMINER

ALI, HATEM M

ART UNIT

PAPER NUMBER

3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/756,090 | Applicant(s) GLEDHILL ET AL. | |
| | Examiner HATEM ALI | Art Unit 3692 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-7, 10-11, 13-14, and 17- 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-7, 10-11, 13-14, and 17-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a **Final Action** on merits in response to the communication received on **9/30/2008**.

Acknowledgement

2. **Clam** status:

- Amended **claims 1, 2, 7, 10, 11, 13 14, 17**
- Cancelled claims : **21**
- As such pending claims: 1-3, 6-7, 10-11, 13-14, and 17-18.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 6-7, 10-11, 13-14, and 17-18** are rejected under 35 U.S.C. 103 (a) as being unpatentable over ***Horan*** et al (2003/0225663) in view of ***DeWolf*** et al (2002/0032626) and ***Bergmann*** et al (2002/0143682).

As per claim 1, *Horan* discloses a method of calculating cost basis of financial asset (see **para 0100**, lines 11-13) comprising:

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automatically, using a computer, (para **0101-0102**) calculating an adjusted cost basis of the asset based upon at least one of: the asset, the reallocation at least one of: the asset, the reallocation of the ownership of the asset and the enhanced categorization to enable tax-related calculations based upon the enhanced categorization (para **0077** and **0099-0100**; via workflow system **208** and accounting and management system **806** respectively);

storing, using the computer the adjusted cost basis in a management system (Fig. 7, Data warehouse **312**).

acquiring, using the computer, cost basis data and tax lot data from the plurality of product systems to enable automated reconciliation of cost basis data and the adjusted cost basis; identifying at least a portion of the tax lot data that was affected by the reallocation (para **0099**, lines 1-3; via record system **806** .. tax-lot accounting ...tax withholding and reclaim processing);

reconciling, using the computer, the cost basis data and the adjusted cost basis of the asset to the plurality of product systems (para **010**, lines 1-12; via open reconciliation system **828** ... the workflow system **810** to resolve the variance); and

preparing a report, using the computer, relating to the adjusted cost basis of the asset based on at least one of: the categorization of the change in the ownership of the asset, the enhanced categorization and the adjusted cost basis of the asset (para **0102**, lines 1-12; via an automated workflow system **810** ... a management reporting system **838**)

Horan fails to explicitly disclose that acquiring, using a computer, a reallocation of an ownership of the asset from a product system, wherein the product system is one of a plurality of product systems from which reallocation data is acquired, wherein the reallocation is triggered by at least one of: **a marriage**, an inheritance, a gift, a partial spin-off, a stock split with owner option, a partial sale of the asset, and a change to an accounting method for the sale of the asset, and wherein the reallocation of the asset is accomplished by the product system.

However, **DeWolf** discloses that acquiring a reallocation of an ownership of the asset from a product system, wherein the product system is one of a plurality of product systems from which reallocation data is acquired, wherein the reallocation is triggered by at least one of: a marriage, an inheritance, a gift, a partial spin-off, a stock split with owner option, a partial sale of the asset, and a change to an accounting method for the sale of the asset, and wherein the reallocation of the asset is accomplished by the product system (**Abstract** - life cycle of the asset and categorizing the information into multiple attribute and **para 0090**, line 5; via ownership disputed as **in divorce** [implied marriage]).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure and features mentioned by **Horan** and to include the disclosure of **DeWolf** to facilitate the legal system to adjust and reallocate the ownership of an asset disputed by divorce implied marriage.

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Horan fails explicitly to disclose further categorizing, using the computer, the reallocation into one of a plurality of at least one of; additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized by the product system into one of a plurality of categories, and wherein the enhanced categorization is associated with a tax treatment of the reallocation.

However, **Bergmann** being in the same field of invention discloses that categorizing, using the computer, the reallocation into one of a plurality of at least one of; additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized by the product system into one of a plurality of categories, and wherein the enhanced categorization is associated with a tax treatment of the reallocation (**para 0045**, line 27; via asset classes, creating accounts and Boxes **8A**, **8B**, **8C** and **9** categorize assets and calculate after-tax returns)

Therefore, it was obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Horan** and to include the feature of **Bergman** to facilitate adjusting the constraint limits on asset classes.

As per claim 2, **Horan** discloses the step of codifying, using the computer, the enhanced_categorization of the. Reallocation of the ownership of the asset prior to automatically calculating the cost basis change of the asset (**para 009-100**; via the

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accounting and record system **806** through a multi-tier client/server technology inherently codifies the system).

As per claim 3, *Horan* discloses the method, wherein the product system is an account (**Fig.9**; via Open Platform-Products and account system).

Claims 4-5 (cancelled).

As per claim 6, *Horan* discloses the method further comprising:

providing a portfolio having a plurality of assets distributed in one or a plurality of product systems (**para 0050 and 0052**; via reallocate a portfolio).

As per claim 7, *Horan* discloses the method, wherein the reallocation of the asset is categorized by the reason for the reallocation (**para 0042**).

Claims 8-9 (cancelled).

As per claim 10, *Horan* discloses the method further comprising utilizing the tax lot data to, using the computer, more accurately determines cost basis change relating to the reallocation of the asset (**para 0100**; via tax lot basis).

As per claim 11, *Horan* discloses a computer-readable medium having stored thereon a plurality of instructions for a portfolio management system, the plurality of instructions (see **Abstract**) comprising:

Instructions to automatically (**para 0101-0102**) calculating an adjusted cost basis of the asset based upon at least one of: the asset, the reallocation at least one of: the asset, the reallocation of the ownership of the asset and the enhanced categorization

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(**para 0077** and **0099-0100**; via workflow system **208** and accounting and management system **806** respectively);

Instructions to storing the adjusted cost basis in a management system_(**Fig. 7**, Data warehouse **312**).

Instructions to acquire cost basis data and tax lot data from the plurality of product systems to enable automated reconciliation of cost basis changes; identifying at least a portion of the tax lot data that was affected by the reallocation (**para 0099**, lines 1-3; via record system **806** .. tax-lot accounting ...tax withholding and reclaim processing);

Instructions to reconciling the cost basis changes of the asset to the plurality of product systems (**para 010**, lines 1-12; via open reconciliation system **828** ... the workflow system **810** to resolve the variance);_and

Instructions to prepare a report relating to the cost basis change of the asset based on at least one of: the categorization of the change in the ownership of the asset, the enhanced categorization and the adjusted cost basis of the asset (**para 0102**, lines 1-12; via an automated workflow system **810** ... a management reporting system **838**)

Horan fails to explicitly disclose that instruction to acquire a reallocation of an ownership of the asset from a product system, wherein the product system is one of a plurality of product systems from which reallocation data is acquired, wherein the reallocation is triggered by at least one of: **a marriage**, an inheritance, a gift, a partial spin-off, a stock split with owner option, a partial sale of the asset, and a change to an

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accounting method for the sale of the asset, and wherein the reallocation of the asset is accomplished by the product system.

However, **DeWolf** discloses that instruction to acquire a reallocation of an ownership of the asset from a product system, wherein the product system is one of a plurality of product systems from which reallocation data is acquired, wherein the reallocation is triggered by at least one of: a marriage, an inheritance, a gift, a partial spin-off, a stock split with owner option, a partial sale of the asset, and a change to an accounting method for the sale of the asset, and wherein the reallocation of the asset is accomplished by the product system (**Abstract** - life cycle of the asset and categorizing the information into multiple attribute and **para 0090**, line 5; via ownership disputed as **in divorce**[implied marriage]).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure and features mentioned by **Horan** and to include the disclosure of **DeWolf** to facilitate the legal system to adjust and reallocate the ownership of an asset disputed by divorce implied marriage.

Horan fails explicitly to disclose instruction to further categorizing the reallocation into one of a plurality of at least one of; additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized by the product system into one of a plurality of categories.

However, **Bergmann** being in the same field of invention discloses that instructions to categorizing the reallocation into one of a plurality of at least one of;

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additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized by the product system into one of a plurality of categories (**para 0045**, line 27; via asset classes, creating accounts and Boxes **8A**, **8B**, **8C** and **9** categorize assets and calculate after-tax returns)

Therefore, it was obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Horan** and to include the feature of **Bergman** to facilitate adjusting the constraint limits on asset classes.

Claim 12 (cancelled)

As per claims 13 -14, Horan discloses the compute-readable medium, wherein the enhanced categorizing of the reallocation of the ownership of the asset into one of a plurality of categories based on the reason for the reallocation of the ownership of the asset (**para 0042** and **0060**; via recordkeeping system **1012** shareowner services **1006** on a wide range of levels and multi-asset class with portfolio accounting **engine 304**, inherent with reasons for reallocation of the ownership of the asset).

As per the claim 17, Horan discloses the computer readable medium further comprising: analyze, the reallocation, the previous categorization and enhanced categorization prior to calculating the cost basis change of the asset (**para 0064**; via portfolio management system **206** includes tools to track positions, perform analytics etc.).

As per claim 18, Horan discloses the computer readable medium further comprising instructions to provide a portfolio having a plurality of assets distributed in

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the plurality of product systems (**para 0039**; via **Fig. 10**, the managed asset platform ... group asset level ...portfolio management system).

Response to Arguments

5. **Applicant's** arguments filed **9/30/08** have been fully considered but they are not persuasive.

In response to **Applicants'** arguments (Remark [1] page 7, para 5; [2] page 8, para 4 and [3] page 9, para 2) that, "[1] **Horan** does not provide the ability to identify and categories certain complex types of changes of ownership ...; [2] While **Bergman** may disclose asset class categorization including tax treatment for the asset class, it does not disclose re-categorizing transactions ... and [3] **DeWolf** provides the ability to track ownership complex types of changes of ownership ... Significantly **DeWolf** does not disclose or contemplate re-categorizing ownership changes of an asset in order to account for tax-treatment. As such, **DeWolf** does not disclose or contemplate *at least* examining both the reallocation data and a further categorization ... calculations", The **Examiner** respectfully does not agree and refers further DeWolf (**para 0048**, line 13-16; via the **GAIR 100** can track ... unlimited number of transactions **210** that occur through the life of the asset 200 [implied multiple number of ownership change, categorization, recategorization, reallocation along with taxation-effect on ownership changes).

Finally, as we understand, references are cited as they teach and suggest the conception of the invention, but not the complete invention applied for.

Conclusion

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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HATEM ALI whose telephone number is (571)270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3692